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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 03-0226 (US01)	
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		First Named Inventor Robert F. Rioux, et al.	
		Art Unit 3736	Examiner Roy, Anuradha
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div><div><p>I am the</p><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest.</p><p>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record.</p><p>Registration number <u>42,339</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</p><p>Registration number _____</p></div><div><p><u>[Signature]</u> Signature</p><p><u>Michael J. Bolan</u> Typed or printed name</p><p><u>949-724-1849</u> Telephone number</p><p><u>1/5/07</u> Date</p></div></div>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Robert Rioux, et al.

Serial No.: 10/766,608

Filed: January 27, 2004

For: **SYSTEMS AND METHODS FOR
TREATING BREAST TISSUE**

)
) **Confirmation No.: 3377**

)
) **Group Art Unit: 3736**

)
) **Examiner: Roy, Anuradha**

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents

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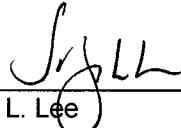
Dear Sir:

Applicant respectfully requests a pre-appeal brief conference. Claims 1-20 and 68-80 remain pending in this application. Claims 3, 5, 6, 10, 12-14, 17, and 18 have been withdrawn from consideration. Claims 1, 7-9, 11, 15, 19, 20, 68-71, and 76-80 stand rejected under 35 U.S.C. §102(e), as being anticipated by U.S. Patent No. 6,840,909, issued to Gatto ("Gatto"); claims 2, 72, and 75 stand rejected under 35 U.S.C. §103, as being obvious over Gatto in view of U.S. Patent No. 5,949,929, issued to Hamm ("Hamm");

CERTIFICATE OF MAILING

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Jocelyn L. Lee

and claims 4, 16, and 74 stand rejected under 35 U.S.C. §103, as being obvious over Gatto in view of U.S. Patent No. 6,497,706, issued to Burbank ("Burbank").

Under 35 U.S.C. §102, to establish a prima facie case of anticipation of claims 1, 7-9, 11, 15, 19, 20, 68-71, and 76-80, each and every element of these claims must be found in Gatto. Under 35 U.S.C. §103, to establish a prima facie case of obviousness of claims 2, 4, 16, 72, 74, and 75, all of the claim limitations must be taught or suggested by Gatto in view of Hamm or Burbank.

The pertinent claim language at issue is "slidably disposable within the [fluid carrying] lumen" (claims 1 and 15) and "slidably disposable within the at least one [fluid carrying] lumen" (claim 71). In concluding that the endoscopy assembly of Gatto includes a fluid carrying lumen in which a tissue diagnostic device and tissue treatment device are slidably disposable, the Examiner contends that the imaging device 12 disposed in the lumen 37 (see Fig. 5) and the laser fiber 50 disposed in the lumen 49 (see Fig. 6) are slidably disposed in the fluid conveying lumen 33 because the lumens 37, 49 are disposed in the lumen 33 (see paragraph bridging pages 6-7 of Office Action, dated October 13, 2006).

However, Applicant disagrees that the lumens 37, 49 are disposed in the fluid conveying lumen 33. In particular, the only way that one lumen can be disposed within another lumen is if they are in a concentric relationship; that is, one lumen is completely surrounded by the other lumen. Otherwise, the respective lumens will be in a side-by-side arrangement, in which case, the lumens cannot be considered to be disposed in one another. As clearly shown in Figs. 5 and 6, the lumen 37 is in a side-by-side relationship

with the fluid conveying lumen 33, and the lumen 49 is in a side-by-side relationship with the fluid conveying lumens 52, 54.

For example, as shown in Fig. 5, the lumen 37 (i.e., the circular space within the cylindrical tube 36) in which the imaging device 12 is disposed is completely separate from the fluid conveying lumen 33 (i.e., the crescent-shaped space within sheath 32); that is, the lumen 37 is above the lumen 33—not contained within it. Thus, the imaging device 12 is not slidably disposed within—but rather slidably disposed above—the fluid conveying lumen 33. As shown in Fig. 6, the lumen 49 in which the laser fiber 50 disposed is completely separate from the fluid conveying lumens 52, 54 (i.e., the two side-by-side half crescent-shaped spaces within sheath 42); that is, the lumen 49 is between the lumens 52, 54. Thus, the laser fiber 50 is not slidably disposed within—but rather slidably disposed between—the fluid conveying lumens 52, 54.

Because each of independent claims 1, 15, and 71 require a tissue diagnostic device and a tissue treatment device slidably disposable within a fluid conveying lumen, and because Gatto does not disclose this arrangement, Applicant believes that the Examiner has not established a prima facie case these independent claims, as well as the claims depending therefrom (claims 7-9, 11, 19, 20, 68-70, and 76-80), are anticipated by Gatto under 35 U.S.C. §102.

Because neither Hamm nor Burbank supplement the failed teachings of Gatto with respect to independent claims 1, 15, and 71, the Examiner has not established a prima facie case that 2, 4, 16, 72, 74, and 75, which depend from claims 1, 15, and 71, are obvious over the combination of Gatto, Hamm, and Burbank under 35 U.S.C. §103.

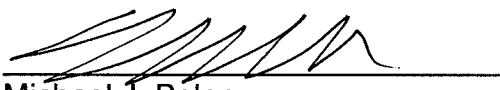
Conclusion

For the reasons set forth above, Applicant respectfully submits that the currently pending claims are patentable over the cited prior art, and thus, a notice of allowance is respectfully requested.

Respectfully submitted,

VISTA IP LAW GROUP LLP

Dated: 1/5/07

By: 
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